



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/688,162	10/17/2003	GeorgeAnn Batis	3052.2.1	9547

7590 03/07/2006

Michael W. Starkweather
Suite 600
8 East Broadway
Salt Lake City, UT 84111

EXAMINER

PICKETT, JOHN G

ART UNIT	PAPER NUMBER
----------	--------------

3728

DATE MAILED: 03/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/688,162

Applicant(s)

BATIS, GEORGEANN

Examiner

Gregory Pickett

Art Unit

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 October 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 October 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/17/03.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Drawings

1. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the plural anchor portions, each designed to hold more than one picture of claim 8 must be shown or the feature(s) canceled from the claim(s). Currently, only one of the anchor portions in Figure 2 is depicted as designed to hold more than one picture. No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 14, 15, and 19 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

The telescoping portions are not described in sufficient detail to enable one of ordinary skill in the art to make the claimed invention. Questions arise as to whether the telescoping portions 68 include multiple pieces that slide amongst each other, or whether the telescoping aspect is merely the sliding of the stem into the holder.

Further, claims 14 and 19 both recite a telescoping stem, for which there is insufficient disclosure as to make-up and function. Questions arise as to whether the stem itself telescopes or if the recitation is merely redundant and the telescoping nature is the stem sliding within the holder, the entire device being considered telescoping. Questions also arise as to the means for holding the portions in either the extended or collapsed states; are they retained by friction or is there a mechanical lock?

Still further, there is insufficient disclosure for the additional telescoping pieces of claim 15; questions arise as to the make-up of these pieces and how they interact with the other pieces to allow for vertical adjustability.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-8, 14, 15, and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

It is unclear as to whether the scrapbook supplies are required for the structure of claim 1, rendering the claim indefinite. To prosecute the examination of the claim on its merits, the examiner assumes the supplies are not a part of the claimed invention.

Claims 2-8 are dependent on claim 1 and are rejected for the above reason.

Claim 14 recites the limitation "the picture holding device" in line 1. There is insufficient antecedent basis for this limitation in the claim. To prosecute the claim on its merits, the examiner assumes the claim to be dependent on claim 11.

Claim 15 is dependent on claim 14 and is rejected for the above reason.

In claim 20, line 2, the claim recites a singular "a" and plural "holders". The number of vertical item holders claimed is indeterminate.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 9-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Mulaw (US 6,692,091).

Claim 9: Mulaw discloses a tool chest (Figure 5) comprising a tool storage area **50** and a picture staging area **82** located above storage area **50**. Mulaw is fully capable of holding supplies for making a scrapbook.

Claim 10: Mulaw discloses vertical item holders **48**, drawer **30**, and compartment **44**.

Claim 11: Mulaw discloses top surface **62** with a picture holding device (housings **70 & 72**).

Claim 12: Mulaw discloses picture retainer (drawer **84**) fully capable of holding pictures as claimed.

Art Unit: 3728

5. Claims 9, 11, 17, and 18 is rejected under 35 U.S.C. 102(b) as being anticipated by Wuerthner et al (EP 554 555 A1; hereinafter Wuerthner).

Claim 9: Wuerthner discloses a tool chest (Figure 1) with a tool storage area **10** and a picture staging area **12** located above tool storage area **10**. Wuerthner is fully capable of holding supplied for making a scrapbook.

Claim 11: Wuerthner discloses top surface **22** and picture holding device **30**.

Claim 17: Wuerthner discloses holding device **30** designed to laterally move along groove **16** by means of stem **14**.

Claim 18: Wuerthner discloses a tool chest (Figure 1) with a tool storage area **10** with a top surface **22** having a groove **16**, and picture staging area **12** with picture holding device **30** designed to laterally move along groove **16** by means of stem **14**.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 3728

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-4, 9-13, and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mulaw in view of Schaak et al (US 2004/0221500 A1; hereinafter Schaak).

Claim 1: Insofar as the examiner can determine the scope of the claim and assuming the supplies are not a part of the claimed invention, Mulaw discloses a tool chest (Figure 5) with a tool holder **10** having a compartment **50** capable of holding different scrapbook supplies. Mulaw lacks, or does not expressly disclose at least one picture holder having an anchor, extension, and resilient portion.

Schaak discloses a picture holder portion with an anchor **20**, extension **22/122**, and resilient picture attachment device **30/40/50/60** with a resilient portion **30**. The device of Schaak is designed for mounting to a surface for decorative purposes and it would have been obvious to one of ordinary skill in the art to place the holder of Schaak on the surface **62** of Mulaw for decorative purposes.

Claim 2: Schaak discloses two picture holders with one taller than the other (see Figure 1).

Claims 3 and 4: Schaak discloses bendable wire stem **30**.

Claims 9-13, and 16: Mulaw-Schaak, as applied to claim 1 above discloses the claimed invention including a tool storage area (Mulaw **50**), a picture staging area (Mulaw **82**), a vertical item holder (Mulaw **48**), a drawer (Mulaw **30**), a compartment

Art Unit: 3728

(Mulaw **44**), a picture holding device (Schaak **20/30/40/50/60**), picture retainer (Schaak **50**), and stem (Schaak **40**).

7. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Wuerthner, as applied to claim 18 above, and further in view of Schroeder (US 3,566,882).

Wuerthner, as applied to claim 18, discloses a tool chest (Figure 1) with a tool storage area **10** with a top surface **22** having a groove **16**, and picture staging area **12** with picture holding device **30** designed to laterally move along groove **16** by means of stem **14**. Wuerthner also discloses vertical item holders **40** and compartment **10'**. Wuerthner merely lacks a drawer.

Schroeder discloses a desk set with drawers **19 & 20**. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the chest of Wuerthner with a drawer as taught by Schroeder in order to store more items.

Allowable Subject Matter

8. Claims 5-8 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

9. Claims 14, 15, and 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 1st and 2nd paragraphs, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

10. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

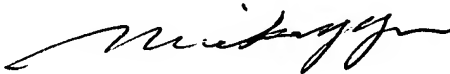
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3728

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Greg Pickett
Examiner
27 February 2006


Mickey Yu
Supervisory Patent Examiner
Group 3700